

Remarks

1. Summary of the Office Action

In the office action mailed March 4, 2010, the Examiner rejected claims 14 and 16-25 under 35 U.S.C. § 112 ¶ 2 as allegedly lacking antecedent basis. Further, the Examiner rejected claims 1, 2, 4, 5, 13, and 15 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0198806 (Banerjee), the Examiner rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being allegedly obvious over Banerjee in view of U.S. Patent Application Pub. No. 2003/0083041 (Kumar), and the Examiner rejected claims 14 and 16-25 under 35 U.S.C. § 103(a) as being allegedly obvious over Banerjee in view of U.S. Patent No. 6,987,987 (Vacanti).

2. Status of the Claims

Applicant has amended claim 14 to remove the term "function" after the term "adding." Applicant submits that this amendment does not change the scope or substance of the claim in any way. Applicant has made this amendment merely to render the Examiner's antecedent basis rejection of claim 14 moot.

Applicant has amended claims 16 and 20 to change "access channel" to "communication path". The inclusion of the term "access channel" was a typographical error, and Applicant submits that one of ordinary skill in the art reading the claims and specification would have clearly understood what was intended. Consequently, Applicant believes that this correction does not change the understood scope of the claim.

Pending are claims 1-6 and 13-25, of which claims 1, 4, 13, 16, and 20 are independent and the remainder are dependent.

3. Response to the Rejections

a. Response to § 112 Rejections

As noted above, the Examiner rejected claim 14 as allegedly lacking antecedent basis for the term "the adding function". However, claim 14 depends from claim 13, which clearly recites the function of "adding an indication". Although the Examiner did not explain the basis for this rejection, Applicant assumes the Examiner took issue with the use of the term "the adding function" because parent claim 13 did not expressly recite the word "function". If this is so, Applicant submits that the rejection improperly exalts form over substance, since it is plainly evident that claim 13 provides full and adequate support for *the function of adding*, otherwise phrased as "*the adding function*." Nevertheless, as noted above, Applicant has amended claim 14 to remove the word "function", thereby rendering the Examiner's rejection moot without substantively changing the clearly understood scope of the claim.

As further noted above, the Examiner rejected claims 16 and 20 as lacking antecedent basis for the term "the access channel." Applicant thanks the Examiner for pointing out this typographical error. Applicant has corrected the claims to recite "the communication path" in place of "the access channel", as was clearly understood. By making this amendment, Applicant does not intend to give up coverage for the communication path being or including an access channel.

b. Response to Rejection of Claims 1-3

Claim 1 recites a method in a communication system wherein a request for web content is transmitted over a communication path from a client station to a content server. According to the method, the following functions are carried out during transmission of the web request within

the communication path, between the client station and the content server: computing a size-based cost to access the web content; engaging in interstitial communication with the client station to receive user approval to pay the size-based cost; and after receiving the user approval, sending the request along to the content server.

The Examiner rejected this claim as being allegedly anticipated by Banerjee. However, this rejection was clearly erroneous because Banerjee does not teach the invention.

Banerjee teaches, at best, the concept of a client station (in particular, a browser in a web enabled device) receiving a first web page that includes a link to a second web page, and the browser itself then determining a cost (possibly size-based cost) to download the second web page (possibly by querying a cost-server) and presenting the determined cost on a user interface for a user to see. The method of Banerjee takes place at the client station and occurs before the client device even requests the second web page, and so *Banerjee sensibly does not mention anything at all about determining a size-based cost for web content during transmission of a request for the web content within the communication path, between the client station and the content server.*

Because Banerjee fails to teach the invention of claim 1, Banerjee does not anticipate claim 1. Therefore, the rejection of claim 1 should be withdrawn, and claim 1 should be allowed. Further, claims 2-3 should be allowed as well for at least the reason that they depend from allowable claim 1.

c. Response to Rejection of Claims 4-6

Independent claim 4 recites a method in a communication system wherein web content is transmitted over a communication path from a content server to a client station. According to

the method, the following functions are carried out during transmission of the web content within the communication path, between the content server and the client station: computing a size-based cost to access the web content; engaging in interstitial communication with the client station to receive user approval to pay the size-based cost; and after receiving the user approval, sending the web content along to the client station.

The Examiner rejected this claim as being allegedly anticipated by Banerjee. However, this rejection was clearly erroneous because Banerjee does not teach the invention.

As noted above, Banerjee teaches, at best, the concept of a client station receiving a first web page that includes a link to a second web page, and the browser itself then determining a cost (possibly size-based cost) to download the second web page (possibly by querying a cost-server) and presenting the determined cost on a user interface for a user to see. The method of Banerjee takes place at the client station and occurs before the client device even requests the second web page, and so *Banerjee sensibly does not mention anything at all about determining a size-based cost for web content during transmission of the web content itself within the communication path, between the client station and the content server.*

Because Banerjee fails to teach the invention of claim 4, Banerjee does not anticipate claim 4. Therefore, the rejection of claim 4 should be withdrawn, and claim 4 should be allowed. Further, claims 5-6 should be allowed as well for at least the reason that they depend from allowable claim 4.

d. Response to Rejection of Claims 13-15

Independent claim 13 recites a method in a communication system wherein web content is transmitted over a communication path from a content server to a client station, the web

content defining a hyperlink to be presented by a browser running on the client station, the hyperlink pointing to referenced web content. As recited, the method involves, during transmission of the web content within the communication path, between the content server and the client station, (i) computing a size-based cost to access the web content and (ii) adding an indication of the size-based cost into the web content, in conjunction with the hyperlink, such that the indication will be presented to a user when the web content is presented to the user.

The Examiner similarly rejected claim 13 as being allegedly anticipated by Banerjee. However, this rejection was clearly erroneous because Banerjee does not teach the invention.

As noted above, Banerjee teaches, at best, the concept of a client station receiving a first web page that includes a link to a second web page, and the browser itself then determining a cost (possibly size-based cost) to download the second web page (possibly by querying a cost-server) and presenting the determined cost on a user interface for a user to see. As noted above, the method of Banerjee takes place at the client station and occurs before the client device even requests the second web page, and so *Banerjee sensibly does not mention anything at all about determining a size-based cost for web content during transmission of the web content itself within the communication path, between the client station and the content server.*

Because Banerjee fails to teach the invention of claim 13, Banerjee does not anticipate claim 13. Therefore, the rejection of claim 13 should be withdrawn, and claim 13 should be allowed. Further, claims 14-15 should be allowed as well for at least the reason that they depend from allowable claim 13.

e. Allowability of Claim 16

Given that claim 16 is now amended to recite "communication path" instead of "access channel", Applicant assumes that the Examiner would have rejected claim 16 on grounds similar to those that the Examiner used for rejecting claims 4 and 13. Thus, Applicant will address the rejection accordingly.

Claim 16 recites a method in a communication system wherein web content is transmitted over a communication path from a content server to a client station. As recited, the method involves during transmission of the web content within the communication path, carrying out the following functions: receiving the web content; detecting a hyperlink within the web content, wherein the hyperlink points to referenced web content; determining a cost of the referenced web content based at least in part on a size of the referenced web content; adding into the web content, in conjunction with the hyperlink, an indication of the determined cost; and sending the web content, including the indication, along the communication path to the client station, whereby the indication will be presented to a user when the web content is presented to the user, thereby giving the user an advanced notice of the cost of the referenced web content.

Banerjee clearly does not teach this invention.

As noted above, Banerjee teaches, at best, the concept of a client station receiving a first web page that includes a link to a second web page, and the browser itself then determining a cost (possibly size-based cost) to download the second web page (possibly by querying a cost-server) and presenting the determined cost on a user interface for a user to see. The method of Banerjee takes place at the client station when the client station receives the first page containing the link to the second page. At that point, it would of course be too late to carry out the

invention of claim 16, since claim 16 requires determining and adding the cost indication in conjunction with the hyperlink before sending the web content (containing that hyperlink and the added cost-indication) along to the client station. Thus, Banerjee does not teach the invention of amended claim 16.

Because Banerjee fails to teach the invention of claim 16, Banerjee does not anticipate claim 16. Therefore, claim 16 should be allowed.

f. Response to Rejection of Claims 14 and 16-25

As noted above, the Examiner rejected claims 14 and 16-25 under 35 U.S.C. § 103(a) as being allegedly obvious over Banerjee in view of Vacanti.

This rejection is improper and should be withdrawn, however, because Vacanti is disqualified as a prior art reference under 35 U.S.C. 103(c).

In particular, at the time the presently claimed invention was made, the application that led to the Vacanti patent (namely, the subject matter of the Vacanti patent) and the presently claimed invention were owned or subject to an obligation of assignment to the same person (Sprint Spectrum L.P.) Under 35 U.S.C. § 103(c), Vacanti therefore cannot be applied as prior art for purposes of a rejection under 35 U.S.C. § 103(a).

Given the disqualification of the Vacanti reference, Applicant submits that *prima facie* obviousness of claims 14 and 16-25 does not exist. Therefore, claims 14 and 16-25 should be allowed.

4. Conclusion

For the foregoing reasons, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Applicant does not acquiesce in any assertion by the Examiner that is not expressly addressed by these remarks.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

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Date: June 4, 2010

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